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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,969	01/21/2000	William J. Baer	STL000017US1	5170

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EXAMINER	
NGUYEN, MAIKHANH	
ART UNIT	**PAPER NUMBER**
2176	

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/488,969	BAER ET AL.	
	Examiner	Art Unit	
	Maikhanh Nguyen	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 December 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Amendment filed 12/15/2005 to the original application filed 01/21/2000.

2. Claims 1-15 are currently pending in this application. Claims 1, 6, and 11 are independent claims.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-5 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

5. The language of claims 1-5 raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a useful, concrete, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

6. Independent claim 1 does not appear to require any computer hardware to implement the claimed invention. These claims appear to define the metes and bounds of an invention

comprised of software alone. There is no support (i.e., explicitly claimed computer hardware) in the body of claim. Software alone, without a machine, is incapable of transforming any physical subject matter by chemical, electrical, or mechanical acts. If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. In re Schrader, 22 F.3d 290 at 294-95, 30 USPQ2d 1455 at 1458-59 (Fed. Cir. 1994). Transformation of data by a machine constitutes statutory subject matter if the claimed invention as a whole accomplishes a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d 1368, 1373, 47 USPQ2d 1596 at 1600-02 (Fed. Cir. 1998). MPEP 2106. State Street required transformation of data by a machine before it applied the "useful, concrete, and tangible test." However, State Street does not hold that a "useful, concrete and tangible result" alone, without a machine, is sufficient for statutory subject matter. State Street, 149 F.3d at 1373, 47 USPQ2d at 1601.

Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or " (Emphasis added.)

8. Claims 1-15 remain rejected under 35 U.S.C. 102(e) as being anticipated **Tabuch** (U.S. 6,606,633 – filed 09/1999).

As to claim 1:

Tabuch teaches a method for providing prerequisite checking in a system for creating compilations from a plurality of content objects stored in a data repository, each content object *(e.g., objects)* comprising a plurality of content entities, some of the content entities *(e.g., data object)* being prerequisites *(e.g., structure rules)* to others of the content entities *(e.g., structure rules defining a possible structure of relations of objects are accumulated and a rule searching means for checking a possibility /impossibility of relating of a data object with reference to the structure rule table; see the Abstract and col.5, lines 12-57)*, comprising the steps of:

> upon addition *(e.g., adding)* or removal *(e.g., deleting)* of a content entity to or from the compilation, determining if the content entity has any prerequisite content entities, and if so, adding *(e.g., adding)* or removing *(e.g., deleting)* the prerequisite content entities *(e.g., see the rule adding and deleting discussion beginning at col.10, line 59).*

As to claim 2:

Tabuch teaches one or more of the prerequisites are conditional *(e.g., the rule searching means 122 sees, when a data object is ...or when to a; col.8, lines 57-62).*

As to claim 3:

Tabuch teaches the conditions for applying a prerequisite are defined in one or more rules *(e.g., rules; see the Abstract).*

As to claim 4:

Tabuch teaches reducing the rule set if possible into a smaller set of rules *(see fig.5 and the deleting a structuring rule from the structuring rule table, beginning at col.11, line 11).*

As to claim 5:

Tabuch teaches the step of rewriting any negative rules as positive rules *(e.g., whether a structuring rule is being used in a compound document object or can not be recognized ... when the number of references of the designated structuring rule is not 0, the structuring rule in question will not be deleted; col.11, lines 23-37).*

As to claim 6:

It is directed to a program storage device for implementing the method of claim 1, and is similarly rejected under the same rationale.

As to claims 7-10:

They include the same limitations as in claims 2-5, respectively, and are similarly rejected under the same rationale.

As to claim 11:

It is directed to a system for performing the method of claim 1, and is similarly rejected under the same rationale.

As to claims 12-15:

They include the same limitations as in claims 2-5, respectively, and are similarly rejected under the same rationale.

Response to Arguments

9. Applicant's arguments filed 12/15/2005 have been fully considered but they are not persuasive.

a. Applicant argues that *Tabuchi does not disclose "**a data repository**" as claimed* [Remarks, page 4].

In response to applicant's arguments, the recitation *"**a data repository**"* has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

b. Applicant argues that *the Examiner is citing Tabuchi's text...would not also correspond to a plurality of content entities* [Remarks, page 4].

The Examiner has considered Applicant's arguments, but maintains that the scope of the claimed ***"content entities"*** clearly transcends the more narrow scope Applicant attempts to impute through argument. Claimed subject matter, not the specification is the measure of the invention. Limitations in the specification cannot be read into the claims for the purpose of avoiding the prior art, In re Self, 213 USPQ 1,5 (CCPA 1982); In re Priest, 199 USPQ 11, 15 (CCPA 1978). The aforementioned claim elements are clearly subject to a broad interpretation, as detailed in the rejections maintained above. The Examiner has a *duty* and *responsibility* to the public and to Applicant to interpret the claims *as broadly as reasonably possible* during prosecution (see *In re Prater, 56 CCPA 1381, 415F.2d 1393, 162 USPQ 541 (1969)*).

c. Applicant argues that *a structure rule is not added to or removed from the compilation according to prerequisite content entities* [Remarks, page 5, 1st full paragraph].

In response, Tabuchi teaches a structure rule is not added to or removed from the compilation according to prerequisite content entities *(e.g., rule adding, deleting, and changing means for executing addition, deletion and change of a structuring rule with respect to the structuring rule table, wherein the contents of the structuring rule table are changed; col.4, lines 43-60).*

d. Applicant argues that *Tachibu does not teach in the case of more than one rule pertaining to the same prerequisite reducing the rule set if possible into a smaller set of rules* [Remarks, page 5, last paragraph].

In response, Tabuch teaches reducing the rule set if possible into a smaller set of rules *(see fig.5 and the deleting a structuring rule from the structuring rule table, beginning at col.11, line 11).*

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cousins et al. U.S. Patent No. 6,351,752 issued: Feb. 26, 2002

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MN

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